

Appl. No. 09/894,317
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Reply to Office Action of 5/20/2004

REMARKS

Claims 1-3, 5, 7-17, 19-22, 24, 26-41, 43, and 45-59 are presently pending in the instant application. Claim 20 has been objected to due to informalities. Claims 17, 19, 20-22, 24, and 26-38 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Additionally, Claims 1, 2, 5, 6-17, 20, 21, 24, and 26-38 have been rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,502,077 issued to Speicher. Also, Claims 39, 40, 41, 43, 45-50, 52 and 54-59 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of U.S. Patent No. 6,285,745 issued to Bartholomew et al. (hereinafter "Bartholomew"). Further, Claims 3, 19, and 22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of U.S. Patent No. 5,544,229 issued to Creswell et al. (hereinafter "Creswell"). Finally, claims 51 and 53 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of Bartholomew and further in view of U.S. Patent No. 6,014,429 to LaPorta et al. (hereinafter "LaPorta").

The applicants have amended claims 1, 2, 7, 17, 19-22, 26, 39-41, 46, and 58 in a non-narrowing manner. The Applicants submit that claims 1-3, 5, 7-17, 19-22, 24, 26-41, 43, and 45-59 are in condition for allowance and respectfully request reconsideration of the outstanding rejections. No new matter has been entered.

Claim Objections

Claim 20 has been objected to due to informalities. The Applicants have amended claim 20 as suggested by the Examiner and submit that claim 20, as amended, is in proper form.

Claim Rejections under 35 USC § 112, second paragraph

Claims 17, 19, 20-22, 24, and 26-38 have been rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention. The Examiner points out that claims 17 and 19 lack antecedent basis and claim 20 is unclear in that it recites that a message identifier for a first voicemail message is delivered to a video mail message system whereby the remaining limitations refer to the voicemail message being accessed and stored in a voice mail box. Claims 21, 22, 24 and 26-38 have been rejected as depending from a rejected base claim. The Applicants have amended claims 17, 19, and 20 accordingly and gratefully acknowledge the Examiner's suggestions. The Applicants submit that the amendments to claims 17, 19, and 20 provide sufficient antecedent basis and conform with the requirements set forth in 35 U.S.C. 112, second paragraph and further submit that claims 17, 19, and 20 are in condition for allowance. Claims 21, 22, 24, and 26-28 depend from what is an allowable claim 20 and, accordingly, are in condition for allowance. The Applicants respectfully request reconsideration of the outstanding rejections.

Claim Rejections under 35 USC 102

Claims 1, 2, 5, 6-17, 20, 21, 24, and 26-38 have been rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Speicher. The Applicants respectfully traverse the outstanding rejections for at least the reasons presented herein.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

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Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Applicants amended claim 1 recites: "A method of providing a status certification for a first voicemail message in a telecommunications network, the telecommunications network including a voicemail system, the voicemail system performing a method, comprising:

receiving the first voicemail message and a status certification request at the voicemail system, the first voicemail message generated by a calling party and distributed to a voicemail box assigned to a recipient of the first voicemail message, wherein the recipient is a subscriber to a voicemail service provided by the voicemail system;

assigning a message identifier to said first voicemail message and creating a temporary voicemail box accessible to the calling party, the calling party being a non-subscriber of the voicemail service;

in response to detecting an occurrence of a disposition event, creating a disposition identifier and associating said disposition identifier with said first voicemail message;

in response to detecting a triggering event, compiling said disposition identifier and said first voicemail message identifier to create a status notification and storing said status notification in the temporary voicemail box; and

providing an access identifier for accessing said temporary voicemail box, wherein an asynchronous dialog is performed between the calling party having said access identifier and the recipient via said temporary voicemail box,

wherein said asynchronous dialog comprises:

accessing said temporary voicemail box with said access identifier;

receiving a second voicemail message;

associating said second voicemail message with said first voicemail message; and

storing said second voicemail message."

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Speicher does not teach each and every element of Applicants' claim 1. Specifically, Speicher does not teach or suggest receiving a first voicemail message and a status certification request at a voicemail system...the voicemail message generated by a calling party and distributed to a voicemail box assigned to a recipient of the voicemail message...the recipient being a subscriber to a voicemail service provided by the voicemail system... and the calling party being a non-subscriber of the voicemail service.

Rather, Speicher is directed to a system and method for implementing a dating service whereby an 'advertiser' (i.e., the person placing or initiating the ad) subscribes to the dating service by providing personal information and a text/audio greeting and, optionally, additional multi-media content to the personal dating service whereby a mailbox is then assigned to the advertiser (i.e., subscriber of the service) (col. 5, lines 55-57; col. 6, lines 17-18). The greeting is stored in the advertiser's own mailbox and that mailbox greeting, in turn, is accessible to any individual with knowledge of the dating service's telephone number (i.e., 900 toll number) and mailbox number, or alternatively, the web site maintained by the dating service (col. 5, lines 55-57; col. 6, lines 33-67; col. 10, line 62 to col. 11, line 7). Thus, a single personal ad stored in a subscriber's mailbox is freely available for access by multiple individuals (i.e., recipients) without restriction. In other words, the advertiser does not direct the ad to a designated target individual's voicemail box and has little, if any, control over who receives the ad's content.

Contrary to the teachings of the personal dating service of Speicher, the voicemail system as recited in Applicants' claim 1 receives a voicemail message that is generated or initiated by a calling party who is not a subscriber to the voicemail service. The voicemail system distributes the first voicemail message to the calling party's intended recipient, the recipient being a subscriber of the service. Thus, the calling party restricts the accessibility of the message by specifying the intended recipient. The voicemail system recited in claim 1 distributes the message directly to the voicemail box of the specified recipient. The calling party who initiates the message is not a subscriber of the voicemail service; rather, it is the recipient of the voicemail who is the subscriber to the service. Moreover, unlike Speicher, the voicemail message generated by the calling party (e.g., advertiser) is not stored in the calling party's voicemail box but rather in the

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recipient's voicemail box.

In addition to the above, Speicher does not teach or suggest "assigning a message identifier to said first voicemail message and creating a temporary voicemail box accessible to the calling party, the calling party being a non-subscriber of the voicemail service..." Speicher teaches a field, AD_MAILBOX_NUMBER 201, that is described in FIG. 2 as "the five digit mailbox number assigned to an advertiser." Further, column 6, lines 17-20 recites "the IVR assigns the advertiser a five digit mailbox number 819. For example: 'Your 5-digit mailbox number is 12345.' The mailbox number is then stored 820 in the field AD_MAILBOX_NUMBER 201." Thus, Speicher teaches a mailbox number assigned to an individual advertiser, whereas, Applicants' claim 1 teaches a message identifier assigned to a voicemail message (for distinguishing one message from another), and not to identify a particular mailbox as is taught by Speicher. Accordingly, the Applicants submit that the message identifier recited in claim 1 is not equivalent to the AD_MAILBOX_NUMBER field as suggested by the Examiner. Moreover, there is nothing in the Speicher reference that teaches or even remotely suggests creating a temporary mailbox. The mailboxes recited in Speicher teach an advertiser mailbox and a respondent mailbox (col. 11, lines 47-48), neither of which are indicated to be temporary. Further, unlike the mailboxes taught by the Speicher reference, the temporary mailbox created as recited in Applicants' claim 1 is created for a non-subscriber (i.e., calling party) of the voicemail service.

Moreover, the Speicher reference does not teach or suggest "in response to detecting an occurrence of a disposition event: creating a disposition identifier and associating said disposition identifier with said first voicemail message; in response to detecting a triggering event: compiling said disposition identifier and said first voicemail message identifier to create a status notification and storing said status notification in the temporary voicemail box..." The disposition event taught by Speicher is directed to a response to the personal ad. The response identifiers taught by Speicher simply provide identifying information relating to a response submitted by a respondent to the ad. Further, the response identifiers recited in Speicher are not associated with the voicemail message, but rather with the voicemail box. In support, Speicher specifically recites "the

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IVR creates a new record in the AD_RESPONSE table FIG. 5 and populates the fields RSP_MAILBOX_NUMBER 501...to indicate the mailbox number of the ad responded to..." (col. 11, lines 59-64). As the disposition identifier of Applicants' claim 1 is not equivalent to the response identifiers of Speicher, it follows that Speicher does not teach or suggest compiling the disposition identifier and first voicemail message identifier to create a status notification. Likewise, as Speicher does not teach a temporary mailbox, it logically follows that Speicher does not teach storing a status notification in a temporary voicemail box as recited in Applicants' claim 1.

Speicher also does not teach or suggest an asynchronous dialog performed between the calling party having the access identifier and the recipient via the temporary voicemail. As submitted above, Speicher does not teach a temporary mailbox. Unlike the teachings of Speicher, the asynchronous dialog as recited in Applicants' claim 1 is enabled between a subscriber of the voicemail service (i.e., calling party) and a non-subscriber (i.e., recipient) via the construction of the temporary voicemail box and identifiers (e.g., voicemail-to-voicemail box communications between parties where one party does not subscribe to the voicemail service).

For at least the reasons presented above, the Applicants submit that claim 1 is patentable over Speicher. Claims 2, 5, and 7-16 depend from claim 1 and are patentable over Speicher at least because of their dependency upon an allowable base claim.

Claim 17 has been amended in a similar manner as recited above with respect to claim 1. Claim 17 is directed to a video mail system. The Applicants submit that claim 17 is patentable over Speicher for at least the reasons presented above with respect to claim 1. Claim 19 depends from claim 17 and is allowable at least for the reason that it depends upon an allowable base claim.

Claim 20 has been amended in a similar manner as described above with respect to claims 1 and 17. Claim 17 is directed to a telecommunications system for performing the methods recited as described in claim 1. The Applicants submit that claim 20 is patentable over Speicher for at least the reasons presented above with respect to claims 1 and 17. Claims 21, 24, 26-38 depend from what is an allowable claim 20 and are patentable over Speicher for at least this reason.

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Claim Rejections under 35 USC § 103

Claims 39, 40, 41, 43, 45-50, 52 and 54-59 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of Bartholomew. Claims 3, 19, and 22 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of Creswell. Claims 51 and 53 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Speicher in view of Bartholomew and further in view of LaPorta. Claim 39 recites an advanced intelligent network for performing the methods as described in claim 1. For at least the reasons provided above with respect to claim 1, the Applicants' submit that claim 39 is patentable over Speicher. Accordingly, combining Speicher with Bartholomew would not result in the Applicants' claim 39. For at least this reason, the Applicants submit that claim 39 is patentable over Speicher in view of Bartholomew. Claims 40, 41, 43, 45-50, 52 and 54-59 depend from claim 39 and are patentable over Speicher in view of Bartholomew for at least because of their dependency. Claim 3 depends from what is an allowable claim 1 and is patentable over Speicher in view of Creswell for at least this reason. Claim 19 depends from an allowable claim 17 and claim 22 depends from an allowable claim 20. The Applicants submit that claims 19 and 22 are patentable over Speicher in view of Creswell at least because of their dependency on allowable base claims. Claims 51 and 53 depend from what is an allowable claim 39 and are patentable over Speicher in view of Bartholomew and further in view of LaPorta at least because of their dependency on an allowable base claim.

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In view of the foregoing remarks, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

By: Marisa J. Dubuc
Marisa J. Dubuc
Registration No. 46,673
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192

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